

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Paul F. Manley, Jr.	§	GROUP ART UNIT: 1761
	§	
FILED: February 23, 2004	§	
	§	
INVENTION: Method For Decorating A Fruit Surface	§	EXAMINER: Sarah Louise Kuhns
	§	
	§	
SERIAL No: 10/784,707	§	ATTY FILE: MANL.00001

APPEAL BRIEF

I.
REAL PARTY IN INTEREST

The real party in interest is Paul F. Manley, Jr.

II.
RELATED APPEALS AND INTERFERENCES

There are not any other appeals or interferences known to appellant, the appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III.
STATUS OF CLAIMS

Claims 1-22 are pending in the instant application of which all claims stand rejected by the Examiner. Claims 1-22 are being appealed.

IV.
STATUS OF AMENDMENTS

No amendments have been filed subsequent to final rejection.

V.
SUMMARY OF CLAIMED SUBJECT MATTER

The present invention of claim 1 is a method for decorating fruit with a design, the method comprising the steps of:

selecting a fruit; (Page 6, lines 21 and 22, Page 7, lines 1-4, and Figure 1, Step 102)

selecting a design to decorate the fruit; (Page 7, lines 5-11 and Figure 1, Step 104)

printing the design; (Page 7, lines 11-13, page 9, lines 20 and 21, and Figure 1, Step 106)

coating the fruit with an edible, substantially water-intolerant coating; and (Page 10, lines 2-4 and Figure 1, Step 108)

attaching the design to the coated fruit (Page 10, lines 8-22, page 11 lines 1-8, and Figure 1, Step 110).

The present invention of claim 19 is a method for decorating fruit with a design, the method comprising the steps of:

selecting a fruit; (Page 6, lines 21 and 22, Page 7, lines 1-4, and Figure 1, Step 102)

selecting a design to decorate the fruit; (Page 7, lines 5-11 and Figure 1, Step 104)

printing the design on a frosting sheet; (Page 7, lines 11-13, page 8, lines 12-19, page 9, lines 20 and 21, and Figure 1, Step 106)

coating the fruit with an edible coating; (Page 10, lines 2-4 and Figure 1, Step 108) and

attaching the frosting sheet to the coated fruit (Page 10, lines 8-22, page 11 lines 1-8, and

Figure 1, Step 110).

The present invention of claim 20 is a method for decorating fruit with a design, the method comprising the steps of:

selecting a fruit; (Page 6, lines 21 and 22, Page 7, lines 1-4, and Figure 1, Step 102)

selecting a design to decorate the fruit; (Page 7, lines 5-11 and Figure 1, Step 104)

printing the design on an edible film with a peelable backing; (Page 7, lines 11-13, page 8, lines 12-19, page 9, lines 20 and 21, and Figure 1, Step 106)

coating the fruit with an edible coating; (Page 10, lines 2-4 and Figure 1, Step 108) and

attaching the edible film to the coated fruit (Page 10, lines 8-22, page 11 lines 1-8, and Figure 1, Step 110).

VI.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

At issue is whether or not claims 1-22 are allowable under 35 U.S.C. § 103(a) in view of Nakanishi, Food Package and Shigeo, JP 55034966, Cone, U.S. Patent 5,229,149; Waters, U.S. Patent 6,376,000, Macpherson; U.S. Patent 5, 017,394; and Stewart, U.S. Patent 6,616,958.

VII.

ARGUMENT

1.

CLAIM REJECTIONS--35 U.S.C. 103

Examiner rejected Claims 1-22 under 35 U.S.C. § 103(a) as being unpatentable over Nakanishi, Food Package. and Shigeo, JP 55034966, in view of Cone, U.S. Patent 5,229,149;

Waters, U.S. Patent 6,376,000, Macpherson; U.S. Patent 5, 017,394; and Stewart, U.S. Patent 6,616,958. This rejection is respectfully traversed because the film used in Nakanishi is to be used on water-soluble foodstuffs, not a substantially water-intolerant coating. (See translation, page 17). In the Office Action, Examiner stated the following:

Nakanishi discloses a method of decorating fruit with a design, comprising of selecting a fruit, selecting a design, printing the design, and attaching the design to the fruit (translation, page 17), as further evidenced by Shigeo (translation, page 2).

(Paper 1 at 3); and

It is conventional in the art to provide coated fruit as evidenced by Cone (column 4, lines 52) and the applicant's admission of prior art. To modify Nakanishi and print on a conventional coated fruit, rather than a conventional uncoated fruit, would have been an obvious matter of choice.

(Paper 1 at 3).

Neither Nakanishi nor Shigeo in view of Cone provide for attaching a printed design on fruit coated in a water intolerant coating; whereas Applicant's invention does provide for such coating. The methods of Nakanishi, Shigeo, and Cone are different and, therefore, the limitations of Claims 1- 22 cannot be mere design choices in view of Nakanishi, Shigeo, Cone, or combinations thereof. Examiner has not shown any evidence that the method for printing a design on fruit as disclosed in Nakanishi and Shigeo would allow for a design to be printed on coated fruit.

One of ordinary skill in the art at the time of the invention would not have made the design modifications to the methods of Nakanishi, Shigeo, and Cone as alleged by Examiner. Cone teaches of coating the fruit with a confectionary coating. Confectionary coatings are well known in the art to be water intolerant. Nakanishi teaches of affixing film on "foods having water content, or when used in foods with almost no water content (dried fruit, F-D foodstuffs,

etc.) (translation, page 17). Similarly, Shigeo teaches of pasting a film on uncoated fruits. Both Nakanishi and Shigeo teach of using a water-soluble film. Such a film would not work on a water intolerant coating. As is well know in the art, to use the water based film disclosed in Nakanishi and Shigeo and the printing methods disclosed in Shigeo with the water-intolerant coating in Cone, as the Examiner has suggested would result in the chocolate seizing and becoming thick, lumpy, grainy, or flakey.

In addition, Waters discloses the use of molds. A mold has a constant shape and planar surfaces. The present invention is used on enrobed fruit which can vary in size and shape in every dimension. Attempting to develop molds for each possible size and shape of fruit would be cost prohibitive. Producing a mold that was larger than any possible fruit would result in a chocolate coating that was too thick to bite through without spoiling the effect of the mix of chocolate and fresh fruit and would be aesthetically unpleasing. Consequently, the molds disclosed in Waters cannot be used on fruit due to the inconsistent shape of fruit. Additionally, the Examiner respectfully requested to view the attached affidavit submitted under 37 CFR 1.132. The affidavit was submitted to show that using Waters to achieve inventors' method is not feasible. Affiant, Paul Manley Jr., has over 7 years of experience in the art and attests that the methods used in Waters could not be used on fruit because Waters discloses molds that have consistent shapes and planar surfaces. Such methods would not work on the inconsistent shape and non-planar surfaces of fruit.

Essentially, one of ordinary skill in the art would not be inclined to modify Nakanishi to be able to decorate fruit coated with a water-intolerant coating. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Since Nakanishi or Shigeo in view of Cone or Waters have no teaching, suggestion, or motivation for modifying the method of printing an image on uncoated fruit disclosed therein, the rejection lacks proper basis and should be withdrawn.

For the reasons stated above and because Claims 2-18 and 21 - 22 depend from Claim 1 which should now be deemed allowable, Examiner is respectfully requested to withdraw the rejections made to Claims 2-18 under 35 U.S.C. § 103. Also, for the reasons stated above, the rejections made to Claims 19 and 20 should be withdrawn.

Examiner rejected Claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Waters, and the admitted prior art in view of Nakanishi and Shigeo. This rejection is respectfully traversed. In the Office Action, Examiner stated the following:

In regards to claim 4, Waters (column 6, line 49) and the applicant's admission of the prior art disclose the use of an inkjet printer for printing designs onto edible sheets. To use this method to print designs for coated fruit would be obvious, in view of Nakanishi and Shigeo, to provide a quick way of printing and designs and an easy way to reproduce designs without changing the consistency of the coating.
(Paper 2 at 3).

Neither Waters, the disclosed prior art, Nakanishi nor Shigeo either alone or in combination disclose Applicant's invention. For the reasons stated above, neither Nakanishi nor Shigeo provide for attaching a printed design on fruit coated in a water intolerant coating. Also, Shigeo teaches away from using an ink jet printer. Shigeo states:

Furthermore, printing in an ink jet method has also been investigated, but despite the fact that expensive printing machines are required in this method, a print image without distortion cannot be obtained.

(Translation, page 3)

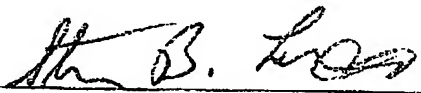
One of ordinary skill in the art at the time of the invention would not have been compelled by Shigeo to modify either Waters or the disclosed prior art to create a method for attaching a printed design on fruit coated in a water intolerant coating. Therefore, neither Waters, the disclosed prior art, Nakanishi nor Shigeo are combinable to render obvious Applicants' invention as proffered by Examiner. In view of the above, Applicants respectfully request the Examiner to withdraw the rejection of Claim 4 under 35 U.S.C. § 103.

CONCLUSION

Appellant prays that the Board will reverse the Examiner's holding of rejection and withdraw all rejections to the above-referenced claims and further find that Claims 1-22 are now in condition for allowance.

Respectfully submitted,

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By: 
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CLAIMS APPENDIX

1. A method for decorating fruit with a design, the method comprising the steps of:
 - selecting a fruit;
 - selecting a design to decorate the fruit;
 - printing the design;
 - coating the fruit with an edible, substantially water-intolerant coating; and
 - attaching the design to the coated fruit.
2. The method of claim 1 wherein the design is printed on an edible sheet.
3. The method of claim 2 wherein the color of the frosting sheet is the same color as the coating.
4. The method of claim 2 wherein the design is printed on the frosting sheet by an inkjet printer.
5. The method of claim 1 wherein the design is printed on an edible film.
6. The method of claim 5 wherein the edible film is releasably attached to a peelable backing.
7. The method of claim 6 wherein the peelable backing is acetate.

8. The method of claim 5 wherein the edible film is chocolate.
9. The method of claim 8 wherein the chocolate is milk chocolate.
10. The method of claim 8 wherein the chocolate is white chocolate.
11. The method of claim 5 wherein the edible film is caramel.
12. The method of claim 1 wherein the coating is a confectionary coating.
13. The method of claim 22 wherein the chocolate is milk chocolate.
14. The method of claim 22 wherein the chocolate is white chocolate.
15. The method of claim 1 wherein the coating is caramel.
16. The method of claim 1 wherein the fruit is selected from the group consisting of strawberries, apples, bananas, cherries, orange slices, and pears.
17. The method of claim 1 wherein the design is attached before the coating is dry.
18. The method of claim 1 wherein the design attached using an adhesive.

19. A method for decorating fruit with a design, the method comprising the steps of:
- selecting a fruit;
 - selecting a design to decorate the fruit;
 - printing the design on a frosting sheet;
 - coating the fruit with an edible coating; and
 - attaching the frosting sheet to the coated fruit.
20. A method for decorating fruit with a design, the method comprising the steps of:
- selecting a fruit;
 - selecting a design to decorate the fruit;
 - printing the design on an edible film with a peelable backing;
 - coating the fruit with an edible coating; and
 - attaching the edible film to the coated fruit.
21. The method of claim 1 wherein the coating is flavored.
22. The method of claim 1 wherein the coating is chocolate.

IX.
EVIDENCE APPENDIX

Evidence submitted pursuant to 37 CFR 1.132:

On July 5, 2005, an Affidavit by Paul F. Manley, Jr., Applicant, was entered into the record by the Examiner and was submitted with Applicant's After Final Amendment and Response on June 17, 2005. The Affidavit is referenced in the instant Appeal Brief on page 5, first full paragraph.

X.
RELATED PROCEEDINGS APPENDIX

None.

PTO/SB/21 (09-06)

Approved for use through 03/31/2007. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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**TRANSMITTAL
FORM**

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission 15

Application Number	10/784,707
Filing Date	February 23, 2004
First Named Inventor	Paul F. Manley
Art Unit	1761
Examiner Name	Arthur L. Corbin
Attorney Docket Number	MANL.00001

ENCLOSURES (Check all that apply)

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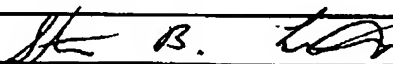
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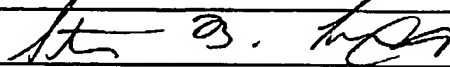
Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Law Office of Steven B. Leavitt, L.L.P.		
Signature			
Printed name	Steven B. Leavitt		
Date	11/20/2006	Reg. No.	45,318

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Signature			
Typed or printed name	Steven B. Leavitt	Date	11/20/2006

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Paul F. Manley	§	GROUP ART UNIT: 1761
	§	
FILED: February 23, 2004	§	
	§	
INVENTION: Method For Decorating A Fruit Surface	§	EXAMINER: Arthur L. Corbin
	§	
SERIAL No: 10/784,707	§	ATTY FILE: MANL.00001

Attention: Examiner Arthur L. Corbin

Per your request, this paper is submitted to correct matters identified in the ORDER REMANDING TO THE EXAMINER issued on August 30, 2006.

Appellant is providing herewith a copy of the originally filed Appeal Brief (pages 1-12) along with the now provided Evidence Appendix (see page 12) and Related Proceeding Appendix (see page 13).

The Evidence Appendix now clarifies that the Affidavit referenced within the Brief on page 5, first full paragraph, is the Affidavit submitted by Applicant on June 17, 2005, which was filed with Applicant's After Final Amendment and Response, and was entered into the record by the Examiner on July 5, 2005.

If the Examiner requires any further assistance with the above matter, the Examiner is cordially invited to contact Steven B. Leavitt at (972) 412-2671.

Respectfully submitted,

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